

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of

Confirmation No: 4958

Dale W. Malik

Group Art Unit: 2152

Serial No.: 10/685,551

Examiner: Hussain, Tauqir

Filed: October 14, 2003

Docket No.: 190250-1350

For: **Transferring Instant Messaging (IM) Messages**

APPEAL BRIEF UNDER 37 C.F.R. §41.37

Mail Stop: Appeal Brief-Patents
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P.O. Box 1450
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Sir:

This Appeal Brief under 37 C.F.R. § 41.37 is submitted in support of the Notice of Appeal filed January 29, 2008, affirming the Advisory Action mailed December 28, 2007 and the Final Office Action mailed August 29, 2007, rejecting claims 1 – 4, 6 – 11, 13 – 19, 21 – 27, and 29.

It is not believed that extensions of time or fees are required to consider this Appeal Brief. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. §1.136(a), and any fees required therefor are hereby authorized to be charged to Deposit Account No. 20-0778.

I. REAL PARTY IN INTEREST

The real party in interest is AT&T Delaware Intellectual Property Inc., formerly known as BellSouth Intellectual Property Corporation, a Corporation of the State of Delaware, having a place of business at 824 Market Street, Suite 425, Wilmington, DE 19801.

II. RELATED APPEALS AND INTERFERENCES

There are no known related appeals or interferences that will affect or be affected by a decision in this Appeal.

III. STATUS OF CLAIMS

Claims currently stand rejected 1 – 4, 6 – 11, 13 – 19, 21 – 27, and 29. No claims have been allowed. Claims 5, 12, 20, and 28 have been canceled. Appellant appeals the final rejection of claims 1 – 4, 6 – 11, 13 – 19, 21 – 27, and 29.

IV. STATUS OF AMENDMENTS

No amendments have been made or requested since the mailing of the FINAL Office Action and all amendments submitted prior to the FINAL action have been entered. The claims in the attached Claims Appendix (see below) reflect the present state of Appellant's claims.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The claimed subject matter is summarized below with reference numerals and references to the written description ("specification") and drawings. The subject matter

described in the following appears in the original disclosure at least where indicated, and may further appear in other places within the original disclosure.

Embodiments according to independent claim 1 describe a communication method (page 35, line 11) that includes receiving an instant messaging (IM) message from a first user to a second user (page 35, line 12) and prompting the first user for permission to convey the IM message to a third user (page 35, line 21). Similarly, embodiments according to claim 1 also include determining whether the second user is currently engaged in an IM chat session with a fourth user (page 36, line 26) and indicating to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user (page 37, line 13).

Embodiments according to independent claim 9 describe a communication method (page 35, line 11) that includes receiving an instant messaging (IM) message from a first user to a second user (page 35, line 12), conveying the IM message to a third user (page 36, line 4), and determining whether the second user is currently engaged in an IM chat session with a fourth user (page 36, line 26). Similarly, embodiments according to independent claim 9 include indicating to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user (page 37, line 13).

Embodiments according to independent claim 14 describe a communication system (element 110 and page 8, line 22) that includes receive logic (element 305 and page 23, line 9) configured to receive an instant messaging (IM) message from a first user to a second user (page 35, line 12) and prompting logic (element 320 and page 23, line 9) configured to prompt the first user for permission to convey the IM message to a third user (page 35, line 21). Embodiments of claim 14 also include determining logic

(element 317 and page 27 line 14) configured to determine whether the second user is currently engaged in an IM chat session with a fourth user (page 36, line 26) and indicating to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user (page 37, line 13).

Similarly, embodiments according to independent claim 15 describe a communication system (element 110 and page 8, line 22) that includes means for receiving an instant messaging (IM) message from a first user to a second user (page 35, line 21) and means for prompting the first user for permission to convey the IM message to a third user (page 35, line 21). The embodiments of claim 15 also describe means for determining whether the second user is currently engaged in an IM chat session with a fourth user (page 36, line 26) and means for indicating to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user (page 37, line 13).

Embodiments according to independent claim 16 describe a computer-readable medium (element 110 and page 8, line 22) that includes computer-readable code adapted to instruct a programmable device to receive an instant messaging (IM) message from a first user to a second user (page 35, line 21) and computer-readable code adapted to instruct a programmable device to prompt the first user for permission to convey the IM message to a third user (page 35, line 21). Embodiments of claim 16 also describe computer-readable code adapted to instruct a programmable device to determine whether the second user is currently engaged in an IM chat session with a fourth user (page 36, line 26) and computer-readable code adapted to instruct a programmable device to indicate to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is

engaged in an IM chat session with the fourth user (page 37, line 13).

Embodiments according to independent claim 23 describe a communication system (element 110 and page 8, line 22) that includes receive logic (element 305 and page 23, line 10) configured to receive an instant messaging (IM) message from a first user to a second user (page 35, line 21) and conveying logic (element 330 and 23, line 11) configured to convey the IM message to a third user (page 36, line 4). Embodiments according to independent claim 23 also include determining logic (element 317 and page 27 line 14) configured to determine whether the second user is currently engaged in an IM chat session with a fourth user (page 36, line 26) and indicating logic configured to indicate to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user (page 37, line 13).

Embodiments according to independent claim 24 describe a communication system (element 110 and page 8, line 22) that includes means for receiving an instant messaging (IM) message from a first user to a second user (page 35, line 21) and means for conveying the IM message to a third user (page 36, line 4). Additionally, embodiments according to claim 24 describe means for determining whether the second user is currently engaged in an IM chat session with a fourth user (page 36, line 26) and means for indicating to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user (page 37, line 13).

Embodiments according to independent claim 25 describe a computer-readable medium (element 110 and page 8, line 22) that includes computer-readable code adapted to instruct a programmable device to receive an instant messaging (IM) message from a first user to a second user (page 35, line 21) and computer-readable code adapted to instruct a programmable device to convey the IM message to a third

user (page 36, line 4). Similarly, embodiments according to independent claim 25 describe computer-readable code adapted to instruct a programmable device to determine whether the second user is currently engaged in an IM chat session with a fourth user (page 36, line 26) and computer-readable code adapted to instruct a programmable device to indicate to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user (page 37, line 13).

VI. GROUNDINGS OF REJECTION TO BE REVIEWED ON APPEAL

Independent claims 1, 9, 14 – 16, and 23 – 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication Number 2003/0120805 (“*Couts*”) in view of U.S. Patent Number 6,981,223 (“*Becker*”). Dependent claims 2 – 4, 6 – 8, 10 – 11, 13, 17 – 19, and 21 – 22 stand rejected under 35 U.S.C. 103(a) U.S. Publication Number 2003/0120805 (“*Couts*”) in view of U.S. Patent Number 6,981,223 (“*Becker*”).

VII. ARGUMENTS

Appellant respectfully submits that Appellant’s claims are patentable under 35 U.S.C. §103(a). In order for a claim to be properly rejected under 35 U.S.C. §103, the teachings of the prior art reference must suggest all features of the claimed invention to one of ordinary skill in the art. See, e.g., *In re Dow Chemical*, 837 F.2d 469, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 642 F.2d 413, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981). Further, “[t]he PTO has the burden under section 103 to establish a prima facie case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would

lead that individual to combine the relevant teachings of the references.” *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

A. The Cited References

1. The *Couts* Reference

Couts discloses “a method for forwarding a communication message intended for one device to another device” (page 1, paragraph [0006]). More specifically, *Couts* discloses [w]henever a target user or, more specifically, the associated target device is not available to receive an incoming message, the system forwards the message to another or next device” (page 2, paragraph [0013]).

2. The *Becker* Reference

Becker discloses “[one or more] pals [that] are represented by a single line that contains the pal’s name, a ‘device presence’ icon to the left of the name, and an ‘availability’ code to the right of the name” (column 8, line 39).

B. Rejection of Claims

1. Claim 1 is Allowable Over *Couts* in view of *Becker*

The Office Action rejects claim 1 under 35 U.S.C. § 103(a) as being allegedly anticipated by *Couts* in view of *Becker*.

Independent claim 1 recites:

A communication method comprising:
receiving an instant messaging (IM) message from a first user to a second user;
prompting the first user for permission to convey the IM message to a third user;
determining whether the second user is currently engaged in an IM chat session with a fourth user; and
indicating to the first user, ***in response to determining that the second user is engaged in an IM chat session with a***

fourth user, that the second user is engaged in an IM chat session with the fourth user.
(emphasis added)

Appellant respectfully submits that claim 1 is allowable over the cited art for at least the reason that neither *Couts* nor *Becker* individually or in combination discloses, teaches, or suggests a “communication method comprising... indicating to the first user, ***in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user***” as recited in claim 1. More specifically, the Office Action admits that *Couts* “is silent on indicating to the first user, that the second user is engaged in an IM chat session with the fourth user” (OA page 3, last paragraph).

Additionally, *Becker* fails to overcome the deficiencies of *Couts*. More specifically, *Becker* discloses an interface (see *Becker* FIG. 5) where “each pal is represented by a single line that contains the pal’s name, a ‘device presence’ icon to the left of the name, and an ‘availability’ code to the right of the name” (column 8, line 39).

Becker continues in stating:

“personal presence” or “availability”... refers to the type of presence of an individual... For example, if an individual is actively working at a computer that is running a browser suitable for instant message exchange, the availability message is “available.” If the person leaves the computer for an extended period of time and the pal’s computer is programmed to detect and signal a prolonged period of inactivity, the availability message is “idle.” If supported by the pal’s computer, a pal may signal certain types of presence such as “out to lunch” or “back in 5 minutes” and so forth.

(column 9, line 29).

Appellant respectfully submits that, as demonstrated in this passage, *Becker* appears to merely indicate Instant Messaging presence to a pal. More specifically, simply indicating that a user is available or idle in no way indicates that a user is engaged in an IM session or with whom the user is engaged in the IM session. Consequently, there is absolutely no disclosure or even suggestion of indicating to a first

user that a second user is engaged in an Instant Messaging session with a fourth user, as recited in claim 1. To further illustrate this point, in FIG. 5 of *Becker*, “Anne” and “Earl” have availability statuses of “in a meeting.” There is absolutely no indication of the parties to the meeting, the type of meeting, whether this is an Internet meeting, a live meeting, or anything associated with this element of claim 1. As such, *Becker* fails to suggest at least this portion of claim 1. For at least these reasons, claim 1 is allowable.

2. Claim 9 is Allowable Over *Couts* in view of *Becker*

The Office Action rejects claim 9 under 35 U.S.C. § 103(a) as being allegedly anticipated by *Couts* in view of *Becker*.

Independent claim 9 recites:

A communication method comprising:
receiving an instant messaging (IM) message from a first user to a second user;
conveying the IM message to a third user;
determining whether the second user is currently engaged in an IM chat session with a fourth user; and
indicating to the first user, ***in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user.***
(emphasis added)

Appellant respectfully submits that claim 9 is allowable over the cited art for at least the reason that neither *Couts* nor *Becker* individually or in combination discloses, teaches, or suggests a “communication method comprising... indicating to the first user, ***in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user***” as recited in claim 9. More specifically, the Office Action admits that *Couts* “is silent on indicating to the first user, that the second user is engaged in an IM chat session with the fourth user” (OA page 3, last paragraph).

Additionally, *Becker* fails to overcome the deficiencies of *Couts*. More specifically, *Becker* discloses an interface (see *Becker* FIG. 5) where “each pal is represented by a single line that contains the pal’s name, a ‘device presence’ icon to the left of the name, and an ‘availability’ code to the right of the name” (column 8, line 39).

Becker continues in stating:

“personal presence” or “availability”... refers to the type of presence of an individual... For example, if an individual is actively working at a computer that is running a browser suitable for instant message exchange, the availability message is “available.” If the person leaves the computer for an extended period of time and the pal’s computer is programmed to detect and signal a prolonged period of inactivity, the availability message is “idle.” If supported by the pal’s computer, a pal may signal certain types of presence such as “out to lunch” or “back in 5 minutes” and so forth.

(column 9, line 29).

Appellant respectfully submits that, as demonstrated in this passage, *Becker* appears to merely indicate Instant Messaging presence to a pal. More specifically, simply indicating that a user is available or idle in no way indicates that a user is engaged in an IM session or with whom the user is engaged in the IM session. Consequently, there is absolutely no disclosure or even suggestion of indicating to a first user that a second user is engaged in an Instant Messaging session with a fourth user, as recited in claim 9. To further illustrate this point, in FIG. 5 of *Becker*, “Anne” and “Earl” have availability statuses of “in a meeting.” There is absolutely no indication of the parties to the meeting, the type of meeting, whether this is an Internet meeting, a live meeting, or anything associated with this element of claim 9. As such, *Becker* fails to suggest at least this portion of claim 9. For at least these reasons, claim 9 is allowable.

3. Claim 14 is Allowable Over *Couts* in view of *Becker*

The Office Action rejects claim 14 under 35 U.S.C. § 103(a) as being allegedly anticipated by *Couts* in view of *Becker*.

Independent claim 14 recites:

A communication system comprising:
receive logic configured to receive an instant messaging (IM) message from a first user to a second user;
prompting logic configured to prompt the first user for permission to convey the IM message to a third user;
determining logic configured to determine whether the second user is currently engaged in an IM chat session with a fourth user; and
indicating to the first user, ***in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user.***
(emphasis added)

Appellant respectfully submits that claim 14 is allowable over the cited art for at least the reason that neither *Couts* nor *Becker* individually or in combination discloses, teaches, or suggests a “communication system comprising... indicating to the first user, ***in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user***” as recited in claim 14. More specifically, the Office Action admits that *Couts* “is silent on indicating to the first user, that the second user is engaged in an IM chat session with the fourth user” (OA page 3, last paragraph).

Additionally, *Becker* fails to overcome the deficiencies of *Couts*. More specifically, *Becker* discloses an interface (see *Becker* FIG. 5) where “each pal is represented by a single line that contains the pal’s name, a ‘device presence’ icon to the left of the name, and an ‘availability’ code to the right of the name” (column 8, line 39). *Becker* continues in stating:

“personal presence” or “availability”... refers to the type of presence of an individual... For example, if an individual is actively working at a computer that is running a browser suitable for instant message exchange, the availability message is “available.” If the person leaves the computer for an extended period of time and the pal’s computer is programmed to detect and signal a prolonged period of inactivity, the availability message is “idle.” If supported by the pal’s computer, a pal may signal certain types of

presence such as “out to lunch” or “back in 5 minutes’ and so forth.
(column 9, line 29).

Appellant respectfully submits that, as demonstrated in this passage, *Becker* appears to merely indicate Instant Messaging presence to a pal. More specifically, simply indicating that a user is available or idle in no way indicates that a user is engaged in an IM session or with whom the user is engaged in the IM session. Consequently, there is absolutely no disclosure or even suggestion of indicating to a first user that a second user is engaged in an Instant Messaging session with a fourth user, as recited in claim 14. To further illustrate this point, in FIG. 5 of *Becker*, “Anne” and “Earl” have availability statuses of “in a meeting.” There is absolutely no indication of the parties to the meeting, the type of meeting, whether this is an Internet meeting, a live meeting, or anything associated with this element of claim 14. As such, *Becker* fails to suggest at least this portion of claim 14. For at least these reasons, claim 14 is allowable.

4. Claim 15 is Allowable Over *Couts* in view of *Becker*

The Office Action rejects claim 15 under 35 U.S.C. § 103(a) as being allegedly anticipated by *Couts* in view of *Becker*.

Independent claim 15 recites:

A communication system comprising:
means for receiving an instant messaging (IM) message
from a first user to a second user;
means for prompting the first user for permission to convey
the IM message to a third user;
means for determining whether the second user is
currently engaged in an IM chat session with a fourth user; and
means for indicating to the first user, ***in response to
determining that the second user is engaged in an IM chat
session with a fourth user, that the second user is engaged in
an IM chat session with the fourth user.***
(emphasis added)

Appellant respectfully submits that claim 15 is allowable over the cited art for at least the reason that neither *Couts* nor *Becker* individually or in combination discloses, teaches, or suggests a “communication system comprising... means for indicating to the first user, ***in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user***” as recited in claim 15. More specifically, the Office Action admits that *Couts* “is silent on indicating to the first user, that the second user is engaged in an IM chat session with the fourth user” (OA page 3, last paragraph).

Additionally, *Becker* fails to overcome the deficiencies of *Couts*. More specifically, *Becker* discloses an interface (see *Becker* FIG. 5) where “each pal is represented by a single line that contains the pal’s name, a ‘device presence’ icon to the left of the name, and an ‘availability’ code to the right of the name” (column 8, line 39).

Becker continues in stating:

“personal presence” or “availability”... refers to the type of presence of an individual... For example, if an individual is actively working at a computer that is running a browser suitable for instant message exchange, the availability message is “available.” If the person leaves the computer for an extended period of time and the pal’s computer is programmed to detect and signal a prolonged period of inactivity, the availability message is “idle.” If supported by the pal’s computer, a pal may signal certain types of presence such as “out to lunch” or “back in 5 minutes” and so forth.

(column 9, line 29).

Appellant respectfully submits that, as demonstrated in this passage, *Becker* appears to merely indicate Instant Messaging presence to a pal. More specifically, simply indicating that a user is available or idle in no way indicates that a user is engaged in an IM session or with whom the user is engaged in the IM session. Consequently, there is absolutely no disclosure or even suggestion of indicating to a first user that a second user is engaged in an Instant Messaging session with a fourth user, as recited in claim 15. To further illustrate this point, in FIG. 5 of *Becker*, “Anne” and

“Earl” have availability statuses of “in a meeting.” There is absolutely no indication of the parties to the meeting, the type of meeting, whether this is an Internet meeting, a live meeting, or anything associated with this element of claim 15. As such, *Becker* fails to suggest at least this portion of claim 15. For at least these reasons, claim 15 is allowable.

5. Claim 16 is Allowable Over *Couts* in view of *Becker*

The Office Action rejects claim 16 under 35 U.S.C. § 103(a) as being allegedly anticipated by *Couts* in view of *Becker*.

Independent claim 16 recites:

A computer-readable medium comprising:
computer-readable code adapted to instruct a programmable device to receive an instant messaging (IM) message from a first user to a second user;
computer-readable code adapted to instruct a programmable device to prompt the first user for permission to convey the IM message to a third user;
computer-readable code adapted to instruct a programmable device to determine whether the second user is currently engaged in an IM chat session with a fourth user; and
computer-readable code adapted to instruct a programmable device to indicate to the first user, ***in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user.***

(emphasis added)

Appellant respectfully submits that claim 16 is allowable over the cited art for at least the reason that neither *Couts* nor *Becker* individually or in combination discloses, teaches, or suggests a “computer-readable medium comprising... computer-readable code adapted to instruct a programmable device to indicate to the first user, ***in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user***” as recited in claim 16. More specifically, the Office Action admits that

Couts “is silent on indicating to the first user, that the second user is engaged in an IM chat session with the fourth user” (OA page 3, last paragraph).

Additionally, *Becker* fails to overcome the deficiencies of *Couts*. More specifically, *Becker* discloses an interface (see *Becker* FIG. 5) where “each pal is represented by a single line that contains the pal’s name, a ‘device presence’ icon to the left of the name, and an ‘availability’ code to the right of the name” (column 8, line 39).

Becker continues in stating:

“personal presence” or “availability”... refers to the type of presence of an individual... For example, if an individual is actively working at a computer that is running a browser suitable for instant message exchange, the availability message is “available.” If the person leaves the computer for an extended period of time and the pal’s computer is programmed to detect and signal a prolonged period of inactivity, the availability message is “idle.” If supported by the pal’s computer, a pal may signal certain types of presence such as “out to lunch” or “back in 5 minutes” and so forth.

(column 9, line 29).

Appellant respectfully submits that, as demonstrated in this passage, *Becker* appears to merely indicate Instant Messaging presence to a pal. More specifically, simply indicating that a user is available or idle in no way indicates that a user is engaged in an IM session or with whom the user is engaged in the IM session. Consequently, there is absolutely no disclosure or even suggestion of indicating to a first user that a second user is engaged in an Instant Messaging session with a fourth user, as recited in claim 16. To further illustrate this point, in FIG. 5 of *Becker*, “Anne” and “Earl” have availability statuses of “in a meeting.” There is absolutely no indication of the parties to the meeting, the type of meeting, whether this is an Internet meeting, a live meeting, or anything associated with this element of claim 16. As such, *Becker* fails to suggest at least this portion of claim 16. For at least these reasons, claim 16 is allowable.

6. **Claim 23 is Allowable Over *Couts* in view of *Becker***

The Office Action rejects claim 23 under 35 U.S.C. § 103(a) as being allegedly anticipated by *Couts* in view of *Becker*.

Independent claim 23 recites:

A communication system comprising:
receive logic configured to receive an instant messaging (IM) message from a first user to a second user;
conveying logic configured to convey the IM message to a third user;
determining logic configured to determine whether the second user is currently engaged in an IM chat session with a fourth user; and
indicating logic configured to indicate to the first user, ***in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user.***
(emphasis added)

Appellant respectfully submits that claim 23 is allowable over the cited art for at least the reason that neither *Couts* nor *Becker* individually or in combination discloses, teaches, or suggests a “communication system comprising... indicating logic configured to indicate to the first user, ***in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user***” as recited in claim 23. More specifically, the Office Action admits that *Couts* “is silent on indicating to the first user, that the second user is engaged in an IM chat session with the fourth user” (OA page 3, last paragraph).

Additionally, *Becker* fails to overcome the deficiencies of *Couts*. More specifically, *Becker* discloses an interface (see *Becker* FIG. 5) where “each pal is represented by a single line that contains the pal’s name, a ‘device presence’ icon to the left of the name, and an ‘availability’ code to the right of the name” (column 8, line 39). *Becker* continues in stating:

“personal presence” or “availability”... refers to the type of presence of an individual... For example, if an individual is actively working at a computer that is running a browser suitable for instant message exchange, the availability message is “available.” If the person leaves the computer for an extended period of time and the pal’s computer is programmed to detect and signal a prolonged period of inactivity, the availability message is “idle.” If supported by the pal’s computer, a pal may signal certain types of presence such as “out to lunch” or “back in 5 minutes’ and so forth.

(column 9, line 29).

Appellant respectfully submits that, as demonstrated in this passage, *Becker* appears to merely indicate Instant Messaging presence to a pal. More specifically, simply indicating that a user is available or idle in no way indicates that a user is engaged in an IM session or with whom the user is engaged in the IM session. Consequently, there is absolutely no disclosure or even suggestion of indicating to a first user that a second user is engaged in an Instant Messaging session with a fourth user, as recited in claim 23. To further illustrate this point, in FIG. 5 of *Becker*, “Anne” and “Earl” have availability statuses of “in a meeting.” There is absolutely no indication of the parties to the meeting, the type of meeting, whether this is an Internet meeting, a live meeting, or anything associated with this element of claim 23. As such, *Becker* fails to suggest at least this portion of claim 23. For at least these reasons, claim 23 is allowable.

7. Claim 24 is Allowable Over *Couts* in view of *Becker*

The Office Action rejects claim 24 under 35 U.S.C. § 103(a) as being allegedly anticipated by *Couts* in view of *Becker*.

Independent claim 24 recites:

A communication system comprising:
means for receiving an instant messaging (IM) message
from a first user to a second user;
means for conveying the IM message to a third user;
means for determining whether the second user is

currently engaged in an IM chat session with a fourth user; and means for indicating to the first user, ***in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user.*** (emphasis added)

Appellant respectfully submits that claim 24 is allowable over the cited art for at least the reason that neither *Couts* nor *Becker* individually or in combination discloses, teaches, or suggests a “communication system comprising... means for indicating to the first user, ***in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user***” as recited in claim 24. More specifically, the Office Action admits that *Couts* “is silent on indicating to the first user, that the second user is engaged in an IM chat session with the fourth user” (OA page 3, last paragraph).

Additionally, *Becker* fails to overcome the deficiencies of *Couts*. More specifically, *Becker* discloses an interface (see *Becker* FIG. 5) where “each pal is represented by a single line that contains the pal’s name, a ‘device presence’ icon to the left of the name, and an ‘availability’ code to the right of the name” (column 8, line 39).

Becker continues in stating:

“personal presence” or “availability”... refers to the type of presence of an individual... For example, if an individual is actively working at a computer that is running a browser suitable for instant message exchange, the availability message is “available.” If the person leaves the computer for an extended period of time and the pal’s computer is programmed to detect and signal a prolonged period of inactivity, the availability message is “idle.” If supported by the pal’s computer, a pal may signal certain types of presence such as “out to lunch” or “back in 5 minutes” and so forth.
(column 9, line 29).

Appellant respectfully submits that, as demonstrated in this passage, *Becker* appears to merely indicate Instant Messaging presence to a pal. More specifically, simply indicating that a user is available or idle in no way indicates that a user is

engaged in an IM session or with whom the user is engaged in the IM session.

Consequently, there is absolutely no disclosure or even suggestion of indicating to a first user that a second user is engaged in an Instant Messaging session with a fourth user, as recited in claim 24. To further illustrate this point, in FIG. 5 of *Becker*, “Anne” and “Earl” have availability statuses of “in a meeting.” There is absolutely no indication of the parties to the meeting, the type of meeting, whether this is an Internet meeting, a live meeting, or anything associated with this element of claim 24. As such, *Becker* fails to suggest at least this portion of claim 24. For at least these reasons, claim 24 is allowable.

8. **Claim 25 is Allowable Over *Couts* in view of *Becker***

The Office Action rejects claim 25 under 35 U.S.C. § 103(a) as being allegedly anticipated by *Couts* in view of *Becker*.

Independent claim 25 recites:

A computer-readable medium comprising:
computer-readable code adapted to instruct a programmable device to receive an instant messaging (IM) message from a first user to a second user;
computer-readable code adapted to instruct a programmable device to convey the IM message to a third user;
computer-readable code adapted to instruct a programmable device to determine whether the second user is currently engaged in an IM chat session with a fourth user; and
computer-readable code adapted to instruct a programmable device to indicate to the first user, ***in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user.***

(emphasis added)

Appellant respectfully submits that claim 25 is allowable over the cited art for at least the reason that neither *Couts* nor *Becker* individually or in combination discloses, teaches, or suggests a “computer-readable medium comprising... computer-readable code adapted to instruct a programmable device to indicate to the first user, ***in***

response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user” as recited in claim 25. More specifically, the Office Action admits that *Couts* “is silent on indicating to the first user, that the second user is engaged in an IM chat session with the fourth user” (OA page 3, last paragraph).

Additionally, *Becker* fails to overcome the deficiencies of *Couts*. More specifically, *Becker* discloses an interface (see *Becker* FIG. 5) where “each pal is represented by a single line that contains the pal’s name, a ‘device presence’ icon to the left of the name, and an ‘availability’ code to the right of the name” (column 8, line 39).

Becker continues in stating:

“personal presence” or “availability”... refers to the type of presence of an individual... For example, if an individual is actively working at a computer that is running a browser suitable for instant message exchange, the availability message is “available.” If the person leaves the computer for an extended period of time and the pal’s computer is programmed to detect and signal a prolonged period of inactivity, the availability message is “idle.” If supported by the pal’s computer, a pal may signal certain types of presence such as “out to lunch” or “back in 5 minutes” and so forth.

(column 9, line 29).

Appellant respectfully submits that, as demonstrated in this passage, *Becker* appears to merely indicate Instant Messaging presence to a pal. More specifically, simply indicating that a user is available or idle in no way indicates that a user is engaged in an IM session or with whom the user is engaged in the IM session. Consequently, there is absolutely no disclosure or even suggestion of indicating to a first user that a second user is engaged in an Instant Messaging session with a fourth user, as recited in claim 25. To further illustrate this point, in FIG. 5 of *Becker*, “Anne” and “Earl” have availability statuses of “in a meeting.” There is absolutely no indication of the parties to the meeting, the type of meeting, whether this is an Internet meeting, a live meeting, or anything associated with this element of claim 25. As such, *Becker* fails to

suggest at least this portion of claim 25. For at least these reasons, claim 25 is allowable.

9. **Claims 2 – 4, 6 – 8, 10 – 11, 13, 17 – 19, 21 – 22, 26 – 27, and 29 are Allowable Over *Couts* in view of *Becker***

Because independent claim 1 is allowable over the cited art of record, dependent claims 2 – 4 and 6 – 7, which depend from independent claim 1, are allowable as a matter of law for at least the reason that the dependent claims contain all of the elements and features of independent claim 1. Similarly, because independent claim 9 is allowable over the cited art of record, dependent claims 10 – 11 and 13, which depend from independent claim 9, are allowable as a matter of law for at least the reason that the dependent claims contain all of the elements and features of independent claim 9. Because independent claim 16 is allowable over the cited art of record, dependent claims 17 – 19 and 21 – 22, which depend from independent claim 16, are allowable as a matter of law for at least the reason that the dependent claims contain all of the elements and features of independent claim 16. Because independent claim 25 is allowable over the cited art of record, dependent claims 26 – 27 and 29, which depend from independent claim 25, are allowable as a matter of law for at least the reason that the dependent claims contain all of the elements and features of independent claim 25.

VIII. Conclusion

Based on the foregoing discussion, Appellant respectfully requests that the Examiner's final rejection of claims 1 – 4, 6 – 11, 13 – 19, 21 – 27, and 29 be overruled by the Board, and that the application be allowed to issue as a patent with all pending claims. In addition to the claims shown in the Claims Appendix IX, Appendix X attached hereto indicates that there is no evidence being attached and relied upon by the brief. Appendix XI attached hereto indicates that there are no related proceedings.

Respectfully submitted,

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Claims Appendix under 37 C.F.R. § 41.37(c)(1)(viii)

The following are the claims that are involved in this Appeal.

1. A communication method comprising:
receiving an instant messaging (IM) message from a first user to a second user;
prompting the first user for permission to convey the IM message to a third user;
determining whether the second user is currently engaged in an IM chat session
with a fourth user; and
indicating to the first user, in response to determining that the second user is
engaged in an IM chat session with a fourth user, that the second user is engaged in an
IM chat session with the fourth user.
2. The method of claim 1, further comprising:
receiving an input from the first user, the input being indicative of the permission
to convey the IM message to the third user; and
conveying the IM message to the third user in response to receiving the input.
3. The method of claim 2, further comprising:
indicating to the first user that the IM message is being conveyed to the third
user.
4. The method of claim 2, further comprising:
indicating to the third user that the IM message originated from the first user.
6. The method of claim 1, further comprising:
waiting a predefined time interval prior to requesting prompting the first user for

permission.

7. The method of claim 6, further comprising:

indicating to the first user, in the absence of a response from the second user during the predefined time interval, that the second user is unavailable.

8. The method of claim 6, wherein requesting permission from the first user

is responsive to an absence of an input from the second user during the predefined time interval.

9. A communication method comprising:

receiving an instant messaging (IM) message from a first user to a second user;

conveying the IM message to a third user;

determining whether the second user is currently engaged in an IM chat session with a fourth user; and

indicating to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user.

10. The method of claim 9, further comprising:

indicating to the first user that the IM message is being conveyed to the third user.

11. The method of claim 9, further comprising:

indicating to the third user that the IM message originated from the first user.

13. The method of claim 9, further comprising:

further indicating to the first user, in response to determining that the first recipient is engaged in an IM chat session with a fourth user, that an IM chat session is being established between the first user and the third user.

14. A communication system comprising:

receive logic configured to receive an instant messaging (IM) message from a first user to a second user;

prompting logic configured to prompt the first user for permission to convey the IM message to a third user;

determining logic configured to determine whether the second user is currently engaged in an IM chat session with a fourth user; and

indicating to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user.

15. A communication system comprising:

means for receiving an instant messaging (IM) message from a first user to a second user;

means for prompting the first user for permission to convey the IM message to a third user;

means for determining whether the second user is currently engaged in an IM chat session with a fourth user; and

means for indicating to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user.

16. A computer-readable medium comprising:

computer-readable code adapted to instruct a programmable device to receive an instant messaging (IM) message from a first user to a second user;

computer-readable code adapted to instruct a programmable device to prompt the first user for permission to convey the IM message to a third user;

computer-readable code adapted to instruct a programmable device to determine whether the second user is currently engaged in an IM chat session with a fourth user; and

computer-readable code adapted to instruct a programmable device to indicate to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user.

17. The computer-readable medium of claim 16, further comprising:

computer-readable code adapted to instruct a programmable device to receive an input from the first user, the input being indicative of the permission to convey the IM message to the fourth user; and

computer-readable code adapted to instruct a programmable device to convey the IM message to the third user in response to receiving input from the first user.

18. The computer-readable medium of claim 17, further comprising:

computer-readable code adapted to instruct a programmable device to indicate to the first user that the IM message is being conveyed to the third user.

19. The computer-readable medium of claim 17, further comprising:

computer-readable code adapted to instruct a programmable device to indicate to the third user that the IM message originated from the first user.

21. The computer-readable medium of claim 16, further comprising:
computer-readable code adapted to instruct a programmable device to wait a predefined time interval prior to requesting the input from the first user.

22. The computer-readable medium of claim 21, further comprising:
computer-readable code adapted to instruct a programmable device to indicate to the first user, in the absence of a response from the second user during the predefined time interval, that the second user is unavailable.

23. A communication system comprising:
receive logic configured to receive an instant messaging (IM) message from a first user to a second user;
conveying logic configured to convey the IM message to a third user;
determining logic configured to determine whether the second user is currently engaged in an IM chat session with a fourth user; and
indicating logic configured to indicate to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user.

24. A communication system comprising:
means for receiving an instant messaging (IM) message from a first user to a second user;
means for conveying the IM message to a third user;

means for determining whether the second user is currently engaged in an IM chat session with a fourth user; and

means for indicating to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user.

25. A computer-readable medium comprising:

computer-readable code adapted to instruct a programmable device to receive an instant messaging (IM) message from a first user to a second user;

computer-readable code adapted to instruct a programmable device to convey the IM message to a third user;

computer-readable code adapted to instruct a programmable device to determine whether the second user is currently engaged in an IM chat session with a fourth user; and

computer-readable code adapted to instruct a programmable device to indicate to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user.

26. The computer-readable medium of claim 25, further comprising:

computer-readable code adapted to instruct a programmable device to indicate to the first user that the IM message is being conveyed to the third user.

27. The computer-readable medium of claim 25, further comprising:

computer-readable code adapted to instruct a programmable device to indicate to the third user that the IM message originated from the first user.

29. The computer-readable medium of claim 25, further comprising:
computer-readable code adapted to instruct a programmable device to further indicate to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user that an IM chat session is being established between the first sender and the third user.

Evidence Appendix under 37 C.F.R. § 41.37(c)(1)(ix)

(none)

Related Proceedings Appendix under 37 C.F.R. § 41.37(c)(1)(x)

(none)